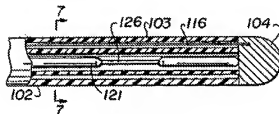


## REMARKS

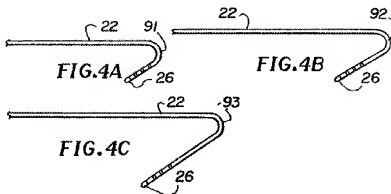
The claims have been amended as indicated above. The amendments are being made to clarify the invention. The amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

102 over Imran

The Office Action rejected claims 1-3, 5-7, 9, 10, and 18-20 under 35 U.S.C. § 102(b) as being anticipated by Imran (5,389,073). Applicants traverse this rejection and request reconsideration because this cited portions of the reference do not teach or suggest the combination as currently claimed. The Office Action cites to Fig. 6 of Imran that discloses an embodiment of a steerable catheter. Fig. 6 is reproduced below for convenience.

**FIG. 6**

This embodiment includes a flexible elongate member (102) with at least three pull wires (116). An elongate stiffening element (121) is slideably mounted in the central lumen (112). Bending of the distal extremity (103) occurs at the weakened longitudinal portion. Citing to Figs. 4A-4C, reproduced below for convenience, the Office Action asserts the bent sections are “generally parallel one another,” although the bent sections are plainly shown as having a significant oblique relationship:

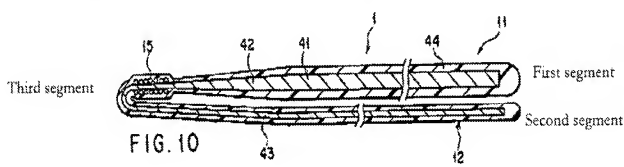


The cited portions of Imran fail to teach or suggest all the limitations recited in the reject claims. For instance, consider independent claims 1 and 20 that currently recite, “the first and second segments being slideably received by a channel associated with an endoscope having a distal end; the first, second, and third segments defining a loop distally beyond the distal end; the first and second segments are independently slideable relative the endoscope to selectively vary the loop geometry.” Also consider independent claim 20 that currently recites, “a flexible third segment . . . being capable of bending . . . where the first and second segments extend proximally from the third segment and generally parallel one another.” Since these and other features recited in the independent claims 1 and 20 are not taught or suggested in the cited portions of Imran, all the independent claims are novel over Imran and should be in a condition for allowance.

Claims 2-3, 5-7, 9, 10, and 18-19 should also be in a condition for allowance by depending from allowable independent claims. Applicants note, however, that the dependent claims recite further limitations that distinguish over the art of record.

#### 103 over Onuki in view of Imran

The Office Action rejected claims 1-19 under 35 U.S.C. § 103(a) as being obvious over Onuki (2002/0087100) in view of Imran (5,389,073). The Office Action cites to Fig. 10 and made the following comparison with the first, second, and third segments:



The Office Action further premises the rejection on the following conclusion: “In use the third segment is bent and provides an elastic hinge.” The Office Action fails provide any support for this conclusion, so it is unclear on what basis this conclusion it drawn. Moreover, this conclusion appears to contradict the intended use of the Onuki. Indeed, the description in paragraphs [0115-0117] describing how Onuki is used suggests that either the retaining wire (12) or wire body (11) are held in place to prevent the other wire from moving. Thus, it appears the

two wires (11, 12) substantially remain in axial alignment and the tip therefore would not bend and provide an elastic hinge as suggested in the Office Action. Accordingly, clarification is requested for the basis of the rejection.

Notwithstanding the foregoing, Applicants traverse the rejections and request reconsideration because a *prima facie* case of obvious has not been established. The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. To establish a *prima facie* case of obviousness, as specified in MPEP § 2143, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicants traverse the obviousness rejections because the cited references do not teach or suggest all the claim limitations (see MPEP § 2143.03). For instance, consider independent claim 1 that currently recites, “the first and second segments being slideably received by a channel associated with an endoscope having a distal end; the first, second, and third segments defining a loop distally beyond the distal end; the first and second segments are independently slideable relative the endoscope to selectively vary the loop geometry.” The cited portions of Onuki fail to teach or suggest these limitations. Further, as discussed above, the cited portions of Imran also fails to teach or suggest these limitations. Since these and other features recited in independent claim 1 are not taught or suggested in the cited portions of Onuki and Imran, a *prima facie* case of obvious has not been established and the claims should be in a condition for allowance.

Beyond the shortcoming with respect to all claim limitations being taught or suggested, a *prima facie* case of obvious has not been established because there is no suggestion or motivation to modify the combined reference teachings (see MPEP § 2143.01). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Neither Onuki or Imran suggest or motivate the combination as

currently recited in the pending claims. Without the requisite teaching, suggestion or motivation, a *prima facie* case of obvious has not been established. In addition, there is no reasonable expectation of success in any such combination (see MPEP § 2143.02), thus further establishing that a *prima facie* case of obvious has not been established.

Claims 2-19 should also be in a condition for allowance by depending from allowable independent claim 1. Applicants note, however, that the dependent claims recite further limitations that distinguish over the art of record.

#### Conclusion

Based on the foregoing, all of the pending claims are in a condition for allowance. Applicants traverse all rejections and request reconsideration, and Applicants request an early notice of allowability.

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Respectfully submitted,

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